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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,380	08/27/2003	Yoshiyuki Tamai	325772033000	5365

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EXAMINER
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PATEL, CHIRAG R

ART UNIT	PAPER NUMBER
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2454

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/648,380		TAMAI ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	CHIRAG R. PATEL		2454	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Response to Arguments***

Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 9, 11-16 and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 5,974,449) in view of Meffert et al. – hereinafter Meffert (US 2003/0037261).

As per claims 1, 2, 4, 13-14, 16, 21-22, and 24, Chang discloses a recording medium in which a program for making a computer execute processing, the processing, comprising:

detecting a recipient's domain name of an e-mail to be transmitted with data attached to the e-mail from a recipient's address of the e-mail; detecting a recipient's server based on the detected recipient's domain name; (Col 17 line 1 – Col 18 line 8, Figure 14)

detecting a response time of the detected recipient's server; (Col 7 line 62 – Col 8 line 11, functionality of 'ping')

deciding a format of the data to be attached to the e-mail depending on the detected response time; (Col 17 lines 40-45, Fig. 14: item 1414)

reformatting the data into the decided format if a current format of the data is different from the decided format; (Abstract, Col 2 lines 6-32, Col 17 lines 1 – Col 18 line 18)

attaching one of the re-formatted data having the decided format or the current format data having the decided format as an attachment to the e-mail; and (Col 15 lines 1-27; server includes the converted document in an email attachment and sends an email containing the attachment using the u-mail address to route the converted document to the targeted subscriber's server via the Internet)

and transmitting one of the re- formatted data having the decided format or the current format data having the decided format to the recipient's address as an attachment of the e-mail. (Col 15 lines 1-27)

Chang fails to disclose wherein the decided format relates to limiting the ability of a user associated with the email to electronically handle the data.

Meffert discloses limiting the ability of a user associated with the email to electronically handle the data. ([0093]; [0108]; multi-page TIFF that is sent, encrypt[ed with dissemination rules; Figure 3)

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Chang to disclose wherein the decided format relates to limiting the ability of a user associated with the email to electronically handle the data. The motivation would have been to improve the security for delivering content

information between the sender and recipient in electronic networks so that the content information cannot be misused, misdelivered or misappropriated by rouge user.

([0017])

As per claims 3, 15, and 23, Chang discloses a recording medium in which a program for making a computer execute processing, the processing, comprising:

receiving a transmission instruction of an e-mail to be transmitted with data attached to the e-mail: detecting a recipient's domain name of the e-mail from a recipient's address of the e-mail based on the received transmission instruction; (Col 17 line 1 – Col 18 line 8, Figure 14)

detecting a recipient's server based on the detected recipient's domain name;

searching a route to the detected server; (Col 17 line 1 – Col 18 line 8)

discriminating whether a relay server having a prescribed property exists on the detected route; (Col 17 line 1 – Col 18 line 8)

deciding a format of the data to be attached to the e-mail depending on the discriminated result; (Col 17 line 1 – Col 18 line 8)

re-formatting the data into the decided format if the current format of the data is different from the decided format; (Abstract, Col 2 lines 6-32, Col 17 line 1 – Col 18 line 8)

attaching one of the re- formatted data having the decided format or the current format data having the decided format as an attachment to the e-mail; and (Col 15 lines 1-27; server includes the converted document in an email attachment and sends an

email containing the attachment using the u-mail address to route the converted document to the targeted subscriber's server via the Internet)

transmitting one of the re-formatted data having the decided format and the current format data having the decided format to the recipient's address as an attachment of the e-mail. (Col 15 lines 1-27)

Chang fails to disclose wherein the decided format relates to limiting the ability of a user associated with the email to electronically handle the data.

Meffert discloses limiting the ability of a user associated with the email to electronically handle the data. ([0093]; [0108]; multi-page TIFF that is sent, encrypt[ed with dissemination rules; Figure 3)

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Chang to disclose wherein the decided format relates to limiting the ability of a user associated with the email to electronically handle the data. The motivation would have been to improve the security for delivering content information between the sender and recipient in electronic networks so that the content information cannot be misused, misdelivered or misappropriated by rouge user. ([0017])

As per claim 9, Chang / Meffert disclose the recording medium as recited in claim 1,. Chang discloses wherein the program stored in the recording medium makes the computer discriminate whether the recipient belongs to the same organization of a

sender based on the detected recipient's domain name and decide a format of the data to be attached to the e-mail based on the discriminated result. (Col 17 lines 40-45)

As per claims 11, 12, and 19-20 Chang / Meffert disclose the recording medium as recited in claim 2, and Chang discloses wherein the response time is detected by executing a connection status searching command against the detected server. (Col 7 line 62 – Col 8 line 11, functionality of 'ping')

As per claim 18, Chang / Meffert disclose the e-mail transmission apparatus as recited in claim 13, and Chang discloses further comprising an original document reading apparatus to obtain image data by reading an original document, wherein the image data read by the original document reading apparatus is transmitted as attached data of the e-mail. (Col 1 lines 42-52)

Claims 5-8, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 5,974,449) / Meffert (US 2003/0037261) further in view of Mai et al. (US 2006/0242311).

As per claims 5-8 and 17, Chang / Meffert discloses the recording medium as recited in claim 1. Chang discloses the program stored in the recording medium makes the computer decide the format of the data every recipient and format the data into respective decided formats. (Col 17 line 1 – Col 18 line 8) Chang fails to disclose where

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the data is transmitted simultaneously to a plurality of recipients. Mai discloses where the data is transmitted simultaneously to a plurality of recipients. ([0010]) At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to where the data is transmitted simultaneously to a plurality of recipients in the disclosure of Chang. The motivation for doing so would have been to deliver IP multicast content to users via a non-multicast enabled network. ([0007])

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 5,974,449) / Meffert (US 2003/0037261) in view of Dunnion et al. – hereinafter Dunnion (US 2002/0199119).

As per claim 10, Chang / Meffert discloses the recording medium as recited in claim 9, Chang discloses wherein in cases where it is discriminated that the recipient belongs to an organization different from an organization of the sender. (Col 17 lines 40-45) Chang fails to disclose the program stored in the recording medium makes the computer format the data into a format which is more difficult to edit the data than a format which is used to transmit the data to the same organization. Dunnion discloses the program stored in the recording medium makes the computer format the data into a format which is more difficult to edit the data than a format which is used to transmit the data to the same organization. ([0123], Table 4, Mail Commands, "Convert from MIME format into proprietary format for efficient transmission." At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to format the



data into a format which is more difficult to edit the data than a format which is used to transmit the data to the same organization in the disclosure of Chang. The motivation for doing so would have been to provide for improved security for email communication. ([0027])

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chirag R Patel whose telephone number is (571)272-7966. The examiner can normally be reached on Monday to Friday from 8:00AM to

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4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached on (571) 272-1915.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

/C. R. P./  
Examiner, Art Unit 2454

/Nathan J. Flynn/  
Supervisory Patent Examiner, Art Unit 2454